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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,223	03/28/2001	Terry L. McMahon	6714.01	2165

25763 7590 02/28/2007  
DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
SUITE 1500  
50 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402-1498

EXAMINER
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NELSON, FREDA ANN

ART UNIT	PAPER NUMBER
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3628

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

09/820,223

Applicant(s)

MCMAHON ET AL.

Examiner

Freda A. Nelson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 23-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The amendment received on February 5, 2007 is acknowledged and entered. Claims 23-26 have been added. Claims 1-22 have been canceled. Claims 23-26 are currently pending.

#### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on February 5, 2007 has been entered.

#### ***Response to Amendment and Arguments***

Applicant's arguments filed February 5, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that Henson fails to disclose or teach providing at least one pre-engineered specification, wherein the pre-engineered specification is a specification for one or more designs of a component for which existing designs have been completed, the examiner respectfully disagrees.

Henson discloses "*with a first generation web based on-line store, a customer was given an ability to select a base computer system (or chassis), customize the*

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*system, and price it (col. 1, line 23-25; see FIG. 3A); and everything in the configurator is specific to a given computer system (i.e., chassis) per customer or per set of customers. The welcome page is geared towards identifying a chassis; and given the chassis, the configurator displays the universe or possible options within that chassis, for a given customer set. Messaging has now been included in that option universe to assist a user in choosing a best selection for that user. If a user decides upon a different chassis, the user must return to the welcome page and select another chassis" (col. 15, lines 30-44).*

The amendment to the claims filed on February 5, 2007 does not fully comply with the requirements of 37 CFR 1.121(c) because applicant have submitted claims 1-17 and 18-22 with incorrect status identifiers.

The correct status is:

1-22. (Canceled).

Amendments to the claims filed on or after July 30, 2003 must comply with 37 CFR 1.121(c) which states:

(c) *Claims.* Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), **(Canceled)**, (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented

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in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (**e.g., Claims 1-5 (canceled)**). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

The amendment has been entered. However, all future correspondence must comply with 37 CFR 1.121(c).

### ***Claim Objections***

Claims 24-26 are objected to because of the following informalities:

In claims 24-26, respectively, insert "wherein" before the second occurrence of "the".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by

Henson (Patent Number 6,167,383).

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As per claim 23, Henson discloses a method in a computerized system for building a custom specification and a quote for a piece of equipment, comprising:

providing at least one pre-engineered specification, wherein the pre-engineered specification is a specification for one or more designs of a component for which existing designs have been completed (col. 1, lines 23-25);

displaying the at least one pre-engineered specification for the equipment (col. 1, lines 23-25);

electronically soliciting from a user a selection of one of the at least one pre-engineered specification (col. 7, line 57 through col. 8, line 6);

electronically soliciting from the user a manufacturer of one component of the equipment (FIG. 3A);

displaying options and prices for the component and allowing the user to select at least one option for the component, wherein the displaying options and prices includes updating the displayed options and prices after an interrelated option has been selected (FIG. 3A-3B and FIGS. 4-6);

generating a report showing the options selected for the component and a subtotal cost for the component (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6); and

generating a report showing the components selected and the total cost of the equipment (col. 6, lines 21-34; FIGS. 3A-3B and FIGS. 4-6).

As per claim 24, Henson discloses the method of claim 23, the equipment is a leased equipment (FIGS. 3A and 4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-26 are rejected under rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (Patent Number 6,167,383), in view of Hanzek (US Patent Number 6,980,963), still in further view of Thompson (US Patent Number 6,810,401).

As per claim 25, Henson does not explicitly disclose that the method of claim 24, wherein the leased equipment is a truck.

However, Hanzek discloses after the on-line consumer selects the vehicle make and model, configurations and options, he/she may submit the vehicle selection and perform a search in inventory to determine if one is currently available. Inventory database 322 receives its data from an inventory importer 328, which obtains inventory data from dealers 330 for their current inventory. Dealers 330 may also represent any sales entity that has an inventory of products for sale or lease to the public or to businesses (col. 8, lines 23-31).

Thompson et al. disclose although the configuration system (and corresponding method) has been specifically described in connection with the configuration of a window/door product, it should be apparent that the system (and method) can be applied to any product, service, or component that is to be designed or configured such as cabinets, rooms, houses, cars, landscape designs, clothing, etc (col. 18, lines 24-31).

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Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Henson et al. to include the feature of Hanzek and Thompson et al. in order to provide the users with the ability to configure and get quotes for vehicles and various other products.

As per claim <sup>26</sup>~~24~~, Henson does not explicitly disclose the method of claim 25, wherein the user is a dealer's salesperson.

However, Hanzek discloses a "consumer" or "customer" can be any purchaser or user of a product, and "product provider" can be, for example, a retailer, dealer or even manufacturer of the product offered for sale. The user interfaces 120 and 122 can be any suitable graphical user interfaces for use over any Internet, intranet, extranet, or similar communication network (col. 2, lines 42-48; FIG. 2 and FIG. 33).

Thompson et al. disclose a user (e.g., consumer, sales-representative, buyer, seller, contractor, builder, architect, consultant, organizer, project coordinator, etc.) of the configuration system interacts with the system to configure and/or estimate the cost of a desired product, component, or project (col. 3, lines 34-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Henson to include the feature of Hanzek and Thompson et al. in order to provide a system for a diversified group of users.



**Conclusion**

3. The examiner has cited prior art of interest, for example:

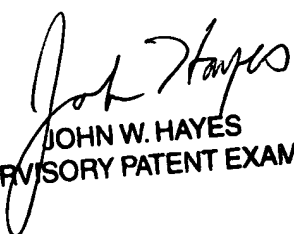
1) Kapadia et al. (US Patent Number 7,039,602), which disclose configuring products with default section determined according to optimization functions.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Freda A. Nelson whose telephone number is (571) 272-7076. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FAN 2/18/2007



JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER